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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,541	02/28/2002	Patrick Johannes Blom	30992US1	9856

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EXAMINER
MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
1772	3

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/085,541	Applicant(s) BLOM ET AL	
	Examiner Michael C. Miggins	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/355,031* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25, 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 and 31 recite the limitation "... at least consisting of ...". It is not clear to one of ordinary skill in the art whether said limitation is open or closed. For purposes of examination said limitation has been construed as comprising.

Claims 25 and 31 are indefinite because both recite the limitation "... a water permeability coefficient, as defined herein ...". Upon reading the claim one or ordinary skill in the art would not be appraised of the metes and bounds of the claim because the water permeability coefficient is not defined in the claim. Although applicant does define the water permeability coefficient in the specification (see page 5), the phrase "... as defined herein ..." should be deleted since applicant does not define the water permeability coefficient in the claim.

3. Claim 32 recites the limitation "the cover layer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Examiner's Comments

Applicant has used the term "... optionally ..." in claims 25, 31 and 33. While said term is not indefinite per se, said term has been construed, for purposes of examination, to mean that the prior art does not have to contain any element which is optional to read on applicant's claims as currently written.

A search of the relevant prior art failed to yield a reference teaching the limitations of instant claims 26, 28 and 33. However, the claims can not be indicated as allowable subject matter because of the double patenting issues as set forth below.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 25-30 and 34-37 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17-25 of prior U.S. Patent No. 6,379,761 B1. This is a double patenting rejection.

Claims 34-37 recite method limitation which depend from a product claim and have been given little to not patentable weight since It has been found that even though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 17-25 of prior U.S. Patent No. 6,379,761 B1 recite a container comprising on at least one surface thereof an ink-only label comprising an adhesive layer, an ink-only image layer wherein the said ink-only label, when applied to a substrate, has a water permeability coeffecient, as defined herein, which is sufficient to enable fast removal of the label from the substrate with water or an aqueous alkaline solution, without destructive treatment of the said substrate (especially since claims 23-24 of U.S. Patent No. 6,379,761 B1 recite a water uptake value after 3 hours greater than 1 and below 75 g/m^2 a water uptake value after 3 hours greater than 1 and below 75 g/m^2) (applies to instant claim 25).

Claims 17-25 of prior U.S. Patent No. 6,379,761 B1 also recite a cover layer applied over the ink-only label which cover layer comprises an acrylic wax, the container further comprising an application surface for receiving the label which application surface has a surface tension of at least 60 Ergs/cm^2, the label on the container having a pencil hardness between 1N and 7N in its dry state and a pencil hardness less than 0.5N after a soaking time between 1 and 15 minutes in water of 20 degrees C, wherein the label on the container has a water uptake value after 3 hours greater than 1 and

below 75 g/m^2, preferably about 5 g/m^2, and the container being selected from the group consisting of plastic crates, plastic bottles and glass bottles.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 31-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-2517-25 of U.S. Patent No. U.S. Patent No. 6,379,761 B1 in view of Brandt et al. (U.S. Patent No. 5,458,714).

Claims 17-25 of prior U.S. Patent No. 6,379,761 B1 recite a container comprising on at least one surface thereof an ink-only label comprising an adhesive layer, an ink-only image layer wherein the said ink-only label, when applied to a substrate, has a water permeability coeffecient, as defined herein, which is sufficient to enable fast removal of the label from the substrate with water or an aqueous alkaline solution, without destructive treatment of the said substrate (especially since claims 23-24 of U.S. Patent No. 6,379,761 B1 recite a water uptake value after 3 hours greater than 1 and

below 75 g/m^2 a water uptake value after 3 hours greater than 1 and below 75 g/m^2) (applies to instant claim 31).

Claims 17-25 of prior U.S. Patent No. 6,379,761 B1 also recite that the cover layer is attached upon or after attaching the ink-only label to the container and wherein the label has been heat-treated after application to the container at a temperature between 40 and 100 degrees C (applies to instant claims 32-33).

Claims 17-25 of prior U.S. Patent No. 6,379,761 B1 substantially recites applicant's claims. However, claims 17-25 of prior U.S. Patent No. 6,379,761 B1 fail to recite a process for applying a label to a container.

Brandt et al. teach a process for applying a label to a container (column 2, lines 38-67) for the purpose of applying labels to containers with high definition print quality.

Therefore it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to have provided a process for applying a label to a container in the invention recited in claims 17-25 of prior U.S. Patent No. 6,379,761 B1) in order to provide a process for applying a label to a container with high definition print quality as taught by Brandt et al..

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 25, 30-31 and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudzik et al. (U.S. Patent No. 4,444,839).

Claims 34-37 recite method limitation which depend from a product claim and have been given little to not patentable weight since It has been found that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe,* 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Dudzik et al. teach a process for applying a label to a container (column 1, lines 5-10) and/or a container comprising on at least one surface thereof an ink-only label comprising an adhesive layer (2 from Fig. 1 and column 3, lines 14-22), an ink-only image layer wherein the said ink-only label (1 from Fig. 1 and column 3, lines 14-22), when applied to a substrate, has a water permeability coeffecient, as defined herein, which is sufficient to enable fast removal of the label from the substrate with water or an aqueous alkaline solution, without destructive treatment of the said substrate (since the label is water soluble in hot or cold water and dissolves in water, see column 1, lines 47-58 and Example 1) (applies to instant claim 25 and 31). Dudzik et al. also teaches that the container is selected from the group consisting of plastic crates, plastic bottles and glass bottles (column 3, lines 1-5) (applies to instant claims 30).

Claim R j ctions - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (U.S. Patent No. 4,444,839).

Dudzik et al. disclose the claimed invention except for a water uptake value after 3 hours greater than 1 and below 75 g/m^2 a water uptake value after 3 hours greater than 1 and below 75 g/m^2. However, Dudzik et al. teach that the label is optionally soluble in hot or cold water thus indicating that the water uptake value is result effective (column 1, lines 47-58). Thus one of ordinary skill in the art would have recognized that a water uptake value after 3 hours greater than 1 and below 75 g/m^2 a water uptake value after 3 hours greater than 1 and below 75 g/m^2 would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a water uptake value after 3 hours greater than 1 and below 75 g/m^2 a water uptake value after 3 hours greater than 1 and below 75 g/m^2 in order to optimize the solubility of the label in water, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or an optimum

value of a result effective variable involves only routine skill in the art (applies to instant claim 27). *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Dudzik et al. disclose the claimed invention except for the container further comprising an application surface for receiving the label which application surface has a surface tension of at least 60 Ergs/cm^2. However, Dudzik et al. teach that the container used is variable (column 3, lines 1-5) and different containers will inherently have different surface tension values. Thus one of ordinary skill in the art would have recognized that the container further comprising an application surface for receiving the label which application surface has a surface tension of at least 60 Ergs/cm^2 would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the container further comprising an application surface for receiving the label which application surface has a surface tension of at least 60 Ergs/cm^2 in order to provide improved adhesion of the label to the container, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or an optimum value of a result effective variable involves only routine skill in the art (applies to instant claim 29). *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (U.S. Patent No. 4,444,839) in view of Brandt et al. (U.S. Patent No. 5,458,714).

Dudzik et al. disclose applicant's invention substantially as claimed. However, Dudzik et al. fail to disclose a process wherein the cover layer is attached upon or after attaching the ink-only label to the container.

Brandt et al. teach a process wherein the cover layer is attached upon or after attaching the ink-only label to the container (column 2, lines 50-63) for the purpose of providing improved impact resistance and durability.

Therefore it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to have provided a process wherein the cover layer is attached upon or after attaching the ink-only label to the container in the process or container of Dudzik et al. in order to provide improved impact resistance and durability as taught by Brandt et al..

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM
July 25, 2003

NASSER AHMAD
PRIMARY EXAMINER
Acting SPE